

REMARKS

I. RESTRICTION REQUIREMENT

A. Initial Restriction

The Office Action states that the present claims comprise two independent inventions as follows:

- Group I claims 1-19, 26-28 are drawn to methods of prognosis of an inflammatory condition based on presence of PAI-1 mutations.
- Group II claims 20-25 are drawn to kits for detecting PAI-1 mutations..

The Action alleges that the restriction is being made because, under PCT Rules, the groups do not relate to a single general inventive concept, and therefor lack the same or a corresponding special technical feature that would define a contribution over the prior. The basis for this position is the conclusion that **Sambrook et al (US Patent 5,866, 413, issued Feb 2, 1999) teaches PAI-1 mutations (see abstract)**. Sambrook teaches specific mutations of PAI-1 in Table VIII. Thus the inventions allegedly lack a *special* technical feature over the prior art and thus lack unity of invention.

B. Further Restriction

Additionally, Groups I and II above were subject to further restriction, as follows:

- Group I: Applicant is required to elect and identify a specific mutation/polymorphism or elect and identify a combination of mutations/polymorphisms for examination from **claim 4, 12, 15**. Examination will be limited to the polymorphism or combination of polymorphisms.
- Group II: Applicant is required to further elect and identify a specific mutation/ polymorphism or elect and identify a combination of mutations /polymorphisms for examination from **claim 21**. Examination will be limited to the polymorphism or combination of polymorphisms.

The Action contends that

- Each polymorphism represents a distinct chemical structure and thus encodes a distinct PAI-1 protein.

(Applicants notes that this is not necessarily so.)

- Each polymorphism or combination of polymorphisms thus require a separate sequence search.
- Each sequence is not obvious over the other sequences.
- Structurally distinct nucleotide sequences are distinct chemical compounds that are unrelated to one another.

The Office therefore deems the sequences to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121, absent evidence to the contrary. Applicant's reply must therefore include (i) an election of a species or invention to be examined even though the requirement be traversed; and (ii) identification of the claims encompassing the elected invention.

C. Restriction between Product and Process Claims

Restriction is required between product (kits) and process claims (methods of prognosis based the presence of PAI-1 mutations (polymorphisms). The Action notes that where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

II. Telephonic Interview of April 16, 2008

The undersigned conducted a telephone interview with the Examiner on April 16, 2008, which was summarized in an Interview Summary Record mailed April 22, 2008. The undersigned inquired about restriction requirement and the examination of the claims, particularly claim 21. The examiner pointed out that claim 21 requires "one or more nucleotide positions." Thus the applicant is allowed to elect one or a combination of nucleotide positions. Not written in the Summary Record, the Examiner indicated that up to 10 total polymorphic sites would normally be searched. The examiner suggested clearly denoting any nucleotide positions that are thought to be novel, as this will speed search and prosecution.

III. APPLICANTS' RESPONSE

Applicants disagree with the Office's position with respect to certain aspects of the Restriction Requirement, as set forth below.

To advance prosecution, however, Applicants elect, Group II (kit claims 20-25), some of which are being amended herein, in accordance with the species election.

The claims of Group I (1-19, 26-28) are withdraw from consideration.

As for a further election of a polymorphic site (Section I/B, above), Applicants elect, with traverse, and in view of the interview, the group of polymorphic positions (or SNPs) located at nucleotide 12580, and with respect to claim 21, combination of this position with positions 7121, 7437, 8070, 8406, 9463, 9466, 12219, 13889 and 14440. (Said otherwise, the SNP at position 5645 is deleted without prejudice). Claim 21 is amended accordingly

Claim 22 is narrowed to one species of this group, nucleotide 12580. The dependency of claims 23 and 25 are being amended to depend from claim 21 instead of claim 20. No new matter is added. If a generic claim is allowed, such as claim 20, Applicants reserve the right to submit claims such as claims 23 and 25, but written to depend from claim 20.

Claims 20-25, which read on the elected invention, remain active in this case after withdrawal of the unelected claims.

With regard to the lack of unity based on the Sambrook reference interpreted under the PCT rules, Applicants believe that the Office has not properly characterized this reference as destroying the novelty of the present claims as this reference does not teach the value or utility of the specific SNPs as prognostic of enhanced or reduced recovery from an inflammatory condition in a subject having, or at risk of developing, the inflammatory condition. Thus, there would be no anticipation or reason for formulating the claimed kits to detect a subjects PAI-1 "genotype" with respect to any SNPs that area associated with recovery from these conditions. Thus the inventions does not lack a *special* technical feature over the prior art and therefore has unity. Applicants respectfully request the withdrawal of the restriction of Group I from Group II and examination of the claims indicated above as being withdrawn, with the appropriate species elections discussed herein applied to the method claims as well.

Applicants believe that the Office has not met its burden under MPEP 806.05(c), whereby the restriction to an individual SNP (or to a single combination), would be justified only if a serious

burden in examining them were to arise absent the restriction. No clear basis for such burden has been set forth in the Action

In view of the foregoing, Applicants respectfully request that the "Further Restriction" be withdrawn and claims 20-25 be examined as a single invention comprising different species with Applicants electing as the initial species the SNP position 12580 and, as a combination for claim 21, the SNPs indicated above. Applicants respectfully request that in reconsidering its position, the Office at least accord the individual SNPs the status of species rather than distinct inventions.

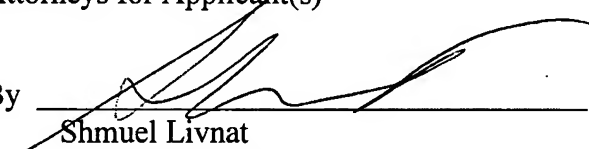
IV. CONCLUSION

Applicants respectfully request entry of the foregoing claims as amended and reconsideration of the restriction requirement as discussed. The application is now in condition for Examination on the merits and allowance.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

By



Shmuel Livnat

Registration No. 33,949

SL:mak

Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528